

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN THE APPLICATION OF: DIANE M. ARTMAN, ET AL.

DOCKET NO.: 3226-01

CUSTOMER NUMBER: 26645

SERIAL NO.: 10/554,481

EXAMINER: TAIWO OLADAPO

FILED: OCTOBER 24, 2005

GROUP ART UNIT: 1797

TITLE: DIESEL LUBRICANT LOW IN SULFUR AND PHOSPHORUS

Dated: October 5, 2009

Hon. Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

REMARKS AND REQUEST FOR RECONSIDERATION

Applicants, through their attorney, respectfully request the Examiner to consider the application in view of the included remarks and the attached 131 Declaration. Consideration of this response after final rejection is requested because it is believed to put the claims in condition for allowance or, alternatively, to simplify issues for possible appeal.

Applicants express their appreciation to the Examiner for his indication that the previous response is persuasive and that all the previous rejections are withdrawn.

The claims have now been rejected as anticipated by Carrick et al., WO 03/022963, or made obvious by the same reference, alone or in combination with certain other references. The publication date of the Carrick WO reference is March 20, 2003. This date is less than one year before the current priority date of April 24, 2003 and thus this document is susceptible to antedating by demonstrating that the present invention was conceived and reduced to practice before that publication date.

CERTIFICATE OF EFS SUBMISSION (37 C.F.R. § 1.8(a)(1)(C))

I hereby certify that this correspondence is being filed electronically via the USPTO EFS to the Commissioner for Patents, United States Patent & Trademark Office, in accordance with §1.6(a)(4) on:

October 21, 2009
Date of Deposit

/Nancy S. Dedek/
Deposited by: Nancy S. Dedek

It is noted that the Carrick WO reference is equivalent to U.S. Patent 6,583,092, which published on June 24, 2003 (after the present priority date) but which was filed on September 12, 2001. The Carrick US document thus might also be considered to be available as a reference under 35 USC 102(e) as of its filing date of September 12, 2001, but it is believed that it would be available under no other sections of 35 USC 102.

Applicants submit herewith a declaration under rule 131 showing that the present invention was completed (conceived and reduced to practice) prior to September 12, 2001. The invention was thus completed prior to the publication date of the Carrick WO reference and also prior to the filing date of the equivalent Carrick US reference. This document is therefore removed as a reference, and all outstanding rejections which rely on this document as a reference are overcome.

The declaration and attached documents show that the blend designated as S010-0120-99-486 was prepared (and therefore necessarily conceived) before September 12, 2001, and that it was also subject to complete engine testing which was completed before that same date. The engine testing demonstrates that the blend was suitable for use as, and in fact was used as, a diesel engine lubricant, thus evidencing complete reduction to practice.

Specifically, the blend S010-0120-99-486 falls within the scope of the present claims in that it included an oil of lubricating viscosity, a nitrogen-free sulfurized olefin antiwear agent (sulfurized 4-carbobutoxycyclohexene) and 7.2% of a nitrogen-containing (succinimide) dispersant (3.6% as the active chemical). The formulation had a phosphorus content of 0.0502%, a sulfur content of 0.2045%, and a sulfated ash level of 0.989%. It was used for lubricating a sump lubricated, compression ignited internal combustion engine, which was inherently accomplished by conducting the M11 diesel engine test and the other diesel engine tests that are reported.

The blend S010-0120-99-486, moreover, appears to be exactly the same formulation that appeared in the Table of the Carrick references, as Example 2 in the Table. (Virginia Carrick and William Abraham are in fact common inventors to both the present invention and the Carrick document.) Plainly, the present inventors had conceived and reduced to practice the present invention before both the publication and the filing of the Carrick references.

Conclusion

For the foregoing reasons it is submitted that the present claims are in condition for allowance. The foregoing remarks are believed to be a full and complete response to the outstanding office action. If the Examiner believes that only minor issues remain to be resolved, a telephone call to the Undersigned is suggested.

Any required fees or any deficiency or overpayment in fees should be charged or credited to The Lubrizol Corporation Deposit Account No. 12-2275.

Respectfully submitted,

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